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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/532,937

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Shuji Doi

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EXAMINER

YAMNITZKY, MARIE ROSE

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

07/20/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/532,937	Applicant(s) DOI ET AL.	
	Examiner Marie R. Yamnitzky	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 2, 12-22 and 31-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-11 and 23-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. This Office action is in response to applicant's amendment filed April 23, 2009, which amends claims 1-3, 6, 7 and 10, and adds claims 31-42.

Claims 1-42 are pending.

2. The claims remain subject to restriction and election of species requirements under 35 U.S.C. 121 and 372. With respect to the election of species requirement, applicant previously elected Polymer Compound H without traverse. Polymer Compound H is a polymer comprising a repeating unit of formula (1) wherein $-X^1-X^2-$ represents $-C(R^1)(R^2)-O-$.

Claim 2 as amended April 23, 2009 does not read on the elected species. Accordingly, claims 2 and 31-42, which depend directly or indirectly from claim 2, are hereby withdrawn from consideration. Previously withdrawn claims 12-22 also remain withdrawn from consideration.

3. Claims 2, 12-22 and 31-42 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions or species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on July 11, 2008.

4. The rejections as applied to claim 2 in the Office action mailed October 23, 2008 are presently considered by the examiner to be moot since claim 2 is now withdrawn from consideration.

The objection to claims 3-5 under 37 CFR 1.75(c) as set forth in the October 23rd action is overcome by amendment.

The rejection of claims 1, 3-11 and 23-20 under 35 U.S.C. 112, 2nd paragraph, is overcome by amendment.

The rejection of claims 1, 6-11 and 23-20 under 35 U.S.C. 102(a) or 102(e) as anticipated by Kobayashi et al. (US 2003/0168656 A1) is overcome by amendment.

The rejection of claims 1, 3-7, 9-11 and 23-30 under 35 U.S.C. 103(a) as unpatentable over Marrocco, III et al. (US 2002/0028347 A1) is overcome by amendment.

5. Claims 6-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is no antecedent basis for “formula (2)” as recited in claims 6, 8 and 9, with claim 7 dependent from claim 6. Claims 6, 8 and 9 depend from claim 1. Claims 6 and 8 recite “the repeating unit represented by the above formula (1) or (2)” and claim 9 recites “the repeating unit represented by formula (1) and (2)”, but formula (2) has been deleted from claim 1.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29

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USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1, 3-11 and 23-30 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-27 of copending Application No. 10/573,839. Although the conflicting claims are not identical, they are not patentably distinct from each other because there is substantial overlap between the polymer and products comprising the polymer per the copending claims, and the polymer and products comprising the polymer per the present claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 1, 3-7, 9-11 and 23-25 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 11/572,513. Although the conflicting claims are not identical, they are not patentably distinct from each other because there is substantial overlap between the polymer and

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products comprising the polymer per copending claims 1-10 and the polymer and products comprising the polymer per present claims 1, 3-7, 9-11, 23 and 25. An ink composition as per present claim 24 would have been obvious to one of ordinary skill in the art given copending claim 11 per which various printing methods can be used to make a film comprising the polymer of copending claim 1.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. Miscellaneous:

Some of the formulae set forth for $-X^1-X^2-$ in claim 1 of the amendment filed April 23, 2009 are not clearly readable, and may result in a printer's rush and/or printing error in the event that claim 1 is allowed and a patent issues from the present application. Applicant is respectfully requested to submit a listing of claims in which all formulae are clearly readable.

In claim 1, the phrase " X^1 and X^2 are not the same," is superfluous given the formulae set forth for $-X^1-X^2-$ in claim 1 of the amendment filed April 23, 2009.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication should be directed to Marie R. Yamnitzky at telephone number (571) 272-1531. The examiner works a flexible schedule but can generally be reached at this number from 7:00 a.m. to 3:30 p.m. Monday and Wednesday-Friday.

The current fax number for all official faxes is (571) 273-8300. (Unofficial faxes to be sent directly to examiner Yamnitzky can be sent to (571) 273-1531.)

/Marie R. Yamnitzky/
Primary Examiner, Art Unit 1794

MRY
July 17, 2009